

ESTTA Tracking number: **ESTTA519647**

Filing date: **02/04/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	VIX SWIMWEAR, INC.
Granted to Date of previous extension	02/06/2013
Address	5735 Kearny Villa Road #108 San Diego, CA 92123 UNITED STATES
Correspondence information	Michael J. Leonard Panitch Schwarze Belisario & Nadel LLP 2005 Market Street - Suite 2200 Philadelphia, PA 19103 UNITED STATES usptotm@panitchlaw.com, mleonard@panitchlaw.com

### Applicant Information

Application No	85611844	Publication date	10/09/2012
Opposition Filing Date	02/04/2013	Opposition Period Ends	02/06/2013
Applicant	BLUE GORILLA LLC 333 PARK AVENUE SOUTH SUITE 42 NEW YORK, NY 10010 UNITED STATES		

### Goods/Services Affected by Opposition


Class 035. First Use: 2012/01/15 First Use In Commerce: 2012/01/15  
All goods and services in the class are opposed, namely: Retail store services featuring clothing and footwear


### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2692225	Application Date	04/16/2001
Registration Date	03/04/2003	Foreign Priority Date	NONE
Word Mark	VIX		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1998/11/25 First Use In Commerce: 1999/02/26 Clothing, namely, swimwear, [ sarongs or ] coverups, bikinis [ and hats ]

U.S. Application No.	85627052	Application Date	05/16/2012
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	VIX		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 2010/11/29 First Use In Commerce: 2010/11/29 All-purpose carrying bags; Beach bags; Book bags; Carry-all bags; Cosmetic bags sold empty; Handbags; Leather handbags; Pouches for holding make-up, keys and other personal items; Purses; Shoulder bags; Tote bags		

Related Proceedings	Opposition No. 91209150 - Application No. 85612038
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Attachments	76239953#TMSN.gif ( 1 page )( bytes ) 85627052#TMSN.jpeg ( 1 page )( bytes ) 00486440.PDF ( 7 pages )(263995 bytes ) 00486445.PDF ( 2 pages )(54911 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/michael leonard/
Name	Michael J. Leonard
Date	02/04/2013

In the matter of Application Serial No. 85/611,844 filed 30 April 2012 by The Ovadafut Hosiery Company, Inc. and assigned on 1 June 2012 to Blue Gorilla LLC (“Applicant”), to register the mark UGLY VIX for services described as “retail store services featuring clothing and footwear” in International Class 35 (“Applicant’s Services”), which was published in the Official Gazette on 9 October 2012, Vix Swimwear Inc. (“Opposer”) of San Diego, California believes it will be damaged by the registration of the UGLY VIX mark and opposes same. The grounds for this opposition are as follows:

1. Upon information and belief, Applicant is a United States corporation having an address in New York, NY. On 30 April 2012, Applicant filed Application Serial No. 85/611844 for the mark UGLY VIX for Applicant's Services based on a claim of use in commerce since 15 January 2012.

2. Opposer is the owner of all right, title and interest in and to the VIX mark of U.S. Trademark Registration No. 2,692,225 covering goods described as “clothing, namely swimwear, coverups, bikinis” in International Class 25. Opposer has been using its VIX mark in connection with the foregoing goods since at least as early as 25 November 1998. Opposer's Registration is valid, subsisting, and incontestable pursuant to 15 U.S.C. § 1065, and is conclusive evidence of the validity of the registered mark, the registration of the mark, Opposer's ownership of the mark, and Opposer's exclusive right to use the VIX Mark in connection with the goods specified in the registration.

3. Opposer is also the owner of pending U.S. Trademark Application Serial No. 85/627,052 for the mark VIX covering goods described as “all-purpose carrying bags; Beach bags; Book bags; Carry-all bags; Cosmetic bags sold empty; Handbags; Leather handbags; Pouches for holding make-up, keys and other personal items; Purses; Shoulder bags; Tote bags;” in Class 18. Opposer has been using its VIX mark in connection with the foregoing goods since at least as early as 29 November 2010. Application Serial No. 85/611,844 for UGLY VIX has been noted as a potential bar to the registration of Opposer's Application Serial No. 85/627,052.

4. Opposer and will rely upon its ownership of the foregoing Registration and Application, as well as the common law rights it has obtained through long prior and continuous use of the VIX Mark in commerce.

5. Commencing long prior to Applicant's filing date and any alleged date of first use that can be claimed by Applicant, Opposer's VIX Mark was used and registered in connection with clothing-related goods.

6. Since the initial use and/or registration of the VIX Mark, Opposer's VIX branded clothing and bags have been advertised and promoted under the VIX Mark. Opposer's customers and the public in general have come to know and recognize Opposer's VIX Mark and associate the Mark with Opposer and/or Opposer's VIX branded clothing and bags.

7. Applicant's filing of Application Serial No. 85/611,844 for UGLY VIX is without license, authorization or permission from Opposer.

**FIRST GROUND FOR OPPOSITION  
(LIKELIHOOD OF CONFUSION - COMMON LAW)**

8. Opposer re-alleges the allegations contained in Paragraphs 1 through 7 of this Notice of Opposition.

9. Opposer uses the VIX Mark to identify various items of clothing and types of bags that are offered and sold to a wide variety of consumers through a variety of retail and wholesale outlets.

10. Applicant's mark wholly incorporates the VIX term and is likely, when used in connection with Applicant's Services, to cause confusion or mistake or to deceive purchasers resulting in damage to Opposer and its reputation.

11. The 15 January 2012 alleged date of first use of the UGLY VIX mark of Application Serial No. 85/611,844 is subsequent to Opposer's 25 November 1998 date of first use of its VIX Mark on clothing and its 29 November 2010 date of first use of the VIX mark on various types of bags.

12. Opposer's VIX branded clothing and bags and Applicant's Services are so closely related and overlapping as Opposer's VIX branded clothing and bags are routinely offered and sold in retail stores featuring clothing and footwear.

13. Opposer's customers, and the public in general, are likely to be confused, mistaken or deceived as to the origin, affiliation, endorsement or sponsorship of Applicant's Services sold and rendered under Applicant's mark and misled into believing that such services are offered by, rendered by, emanate from or are in some way associated with Opposer, to the damage and detriment of Opposer and its reputation.

14. Opposer will be damaged by the registration of the UGLY VIX mark as set forth in Application Serial No. 85/611,844, in that the mark is confusingly similar to Opposer's VIX Mark, thereby violating Opposer's common law rights to its VIX Mark.

15. Registration of Applicant's mark should not be granted, as it is contrary to 15 U.S.C. § 1052(d) and would violate and diminish the prior and superior rights of Opposer to its VIX Mark.

**SECOND GROUND FOR OPPOSITION  
(LIKELIHOOD OF CONFUSION - FEDERAL)**

16. Opposer re-alleges the allegations contained in Paragraphs 1 through 15 of this Notice of Opposition.

17. Applicant's mark fully incorporates the identical VIX term and is likely, when used in connection with Applicant's Services, to cause confusion or mistake or to deceive purchasers resulting in damage and detriment to Opposer and its reputation.

18. Applicant's filing date of 30 April 2012 is subsequent to the 4 March 2003 registration date of U.S. Registration No. 2,692,225 and the 29 November 2010 date of first use of the VIX mark of Application Serial No. 85/627,052.

19. Applicant's Services as identified in Application Serial No. 85/611,844 are not limited by channels of trade and/or classes of purchasers. As such, Opposer's VIX branded clothing and bags and Applicant's Services can be deemed to be so closely related and overlapping that they are offered and sold/rendered and/or are likely to be offered and sold/rendered through the same channels of trade and purchased by the same class of purchasers.

20. Opposer's customers, and the public in general, are likely to be confused, mistaken or deceived as to the origin, affiliation, endorsement and sponsorship of Applicant's Services rendered, offered and marketed under Applicant's UGLY VIX mark and misled into believing that such Services are offered, rendered by, or are in some way associated with Opposer and/or its VIX Mark, to the damage and detriment of Opposer and its reputation.

21. The combination of the negatively viewed term UGLY with Opposer's well known VIX trademark to form Applicant's composite UGLY VIX mark evokes a commercial impression that is derogatory and serves to tarnish and damage the valuable goodwill earned as a result of Opposer's longtime use of its VIX trademark.

22. Opposer will be damaged by Applicant's registration of the UGLY VIX mark as set forth in Application Serial No. 85/611,844 in that Applicant's UGLY VIX mark is confusingly similar to Opposer's VIX Mark and is allegedly being used in connection with Services that are similar, overlapping and/or closely related to Opposer's VIX branded clothing and bags.

23. Applicant's registration of the UGLY VIX mark would be contrary to 15 U.S.C. § 1052(d) and would violate and diminish the prior and superior rights of Opposer to its VIX Mark.




WHEREFORE, Opposer prays that its Opposition be sustained, that Application Serial No. 85/611,844 be refused and that the registration of UGLY VIX as a service mark to Applicant be refused, and for such other relief as may be deemed just and proper.

Respectfully submitted,

VIX SWIMWEAR, INC.

Date: 4 Feb 2013

By:



Michael J. Leonard

John P. Sullivan

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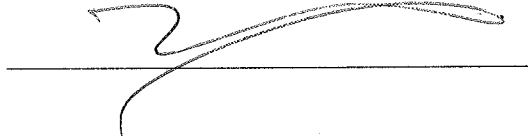
[usptotm@panitchlaw.com](mailto:usptotm@panitchlaw.com)

Attorneys for Opposer

## **CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing Notice of Opposition was served on Applicant this 4<sup>th</sup> day of February 2013 by sending same via First Class Mail, postage prepaid, to:

Susan M. Natland  
Knobbe Martens Olson & Bear LLP  
2040 Main St Fl 14  
Irvine, CA 92614-8214



Side - 1

**NOTICE OF ACCEPTANCE AND  
ACKNOWLEDGEMENT OF §§8 & 15  
DECLARATION  
MAILING DATE: Mar 6, 2009**

The combined declaration of use and incontestability filed in connection with the registration identified below meets the requirements of Sections 8 and 15 of the Trademark Act, 15 U.S.C. §1058 and 1065. The combined declaration is accepted and acknowledged. The registration remains in force.

For further information about this notice, visit our website at: <http://www.uspto.gov>. To review information regarding the referenced registration, go to <http://tarr.uspto.gov>.

**REG NUMBER: 2692225**  
**MARK: VIX**  
**OWNER: VIX SWIMWEAR, INC.**

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UNITED STATES PATENT AND TRADEMARK OFFICE  
COMMISSIONER FOR TRADEMARKS  
P.O. BOX 1451  
ALEXANDRIA, VA 22313-1451

**FIRST-CLASS  
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Int. Cl.: 25

Prior U.S. Cls.: 22 and 39

Reg. No. 2,692,225

**United States Patent and Trademark Office**

Registered Mar. 4, 2003

**TRADEMARK  
PRINCIPAL REGISTER**

**VIX**

VIX SWIMWEAR, INC. (CALIFORNIA CORPORATION)  
315 WESTBOURNE ST  
LA JOLLA, CA 92037

FIRST USE 11-25-1998; IN COMMERCE 2-26-1999.

SER. NO. 76-239,953, FILED 4-16-2001.

FOR: CLOTHING, NAMELY, SWIMWEAR, SARONGS OR COVERUPS, BIKINIS AND HATS, IN CLASS 25 (U.S. CLS. 22 AND 39).

ALICE SUE CARRUTHERS, EXAMINING ATTORNEY